

application for the present specification, which is U.S. 2005/0081456, and the information that is in the "PAIR" system of the USPTO website.

Applicants have discovered that the published patent application is, in fact, a publication of the translation of the U.S. provisional application and is not a publication of the translated application that applicants filed on July 9, 2004. The published document contains a Fig. 1(A) and (B). In contrast, the drawing that applicants filed with the application on January 5, 2004, contains a Fig. 1 and a Fig. 2.

By looking at the "PAIR" website, applicants found in the Image File Wrapper entry sheet, under the mailroom date of January 5, 2004, a copy of the drawing that applicants filed on January 5, 2004 with Fig. 1 and Fig. 2. Apparently, the Examiner was looking at the wrong drawing when he reviewed the file. Accordingly, applicants submit that the present specification does contain a Fig. 1 and a Fig. 2 drawing and, therefore, request withdrawal of this objection..

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as anticipated by JP 61-17405.

Applicants submit that JP 61-17405 does not disclose the subject matter of claims 1 and 2 and, accordingly, request withdrawal of this rejection.

The Examiner argues that the cubic boron nitride abrasive grains formed according to the process of JP 61-17405 would inherently have the properties recited in applicants' claims 1 and 2.

The Examiner refers to the English Abstract of JP 61-751118. Applicants believe the Examiner intended to refer to the English Abstract of JP 61-17405 which he attached to the

Office Action. Applicants do not know what the Examiner intended when he referred to JP 61-751118.

Applicants disagree with the Examiner that the cubic boron nitride abrasive grains formed according to the process of JP 61-17405 would inherently have the properties recited in applicant's claims 1 and 2.

JP 61-17405 does not disclose cubic boron nitride abrasive grains which are substantially mono-crystalline and assume a black color as recited in claim 1 of the present application. On the contrary, JP 61-17405 indirectly discloses, at page 2, right-upper column and left-lower column, that "according to this manufacturing method for cubic boron nitride, cubic boron nitride substantially assuming non-color (transparent) can be obtained".

As shown in Table 4 of the present specification, the grinding wheel of Example 7 employing the cubic boron nitride abrasive grains of the present invention, which are substantially mono-crystalline and assume a *black color*, provides improved surface roughness of ground workpieces as compared with that of workpieces ground by a grinding wheel (i.e., Comparative Example 7) employing conventional abrasive grains, which assume a *yellow color* (i.e., Comparative Example 2) and which have been developed so as to reduce grinding power, while in addition, the grinding wheel of the present invention (Example 7) operates with reduced grinding power of the same level as that attained by use of a grinding wheel (i.e., Comparative Example 7) employing the conventional abrasive grains.

As stated above, JP 61-17405 does not disclose cubic boron nitride abrasive grains which are substantially mono-crystalline and assume a black color, and which exhibit superior

properties than conventional non-black cubic boron nitride abrasive grains. Therefore, applicants submit that JP 61-17405 does not anticipate claim 1, and that the rejection of claim 1 based on JP 61-17405 should be withdrawn.

Further, JP 61-17405 does not disclose packing ratios defined by grit size fractions as recited in claim 2. Therefore, applicants submit that JP 61-17405 does not anticipate claim 2 and that the rejection of claim 2 based on JP 61-17405 should be withdrawn.

In view of the above, applicants submit that JP 61-17405 does not disclose the subject matter of claims 1 and 2 and, accordingly, request withdrawal of this rejection.

Claims 1 and 2 have been rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Published Patent Application 2005/0220690 to Ohtsubo.

In essence, the Examiner states that the cubic boron nitride grains formed according to the process of Ohtsubo would inherently have the properties recited in claims 1 and 2.

Applicants disagree with the Examiner that the cubic boron nitride abrasive grains formed according to the process of Ohtsubo '690 would inherently have the properties as recited in applicant's claims 1 and 2.

Ohtsubo '690 does not disclose cubic boron nitride abrasive grains which are substantially mono-crystalline and assume a black color as recited in claim 1 of the present application. Therefore, applicants submit that Ohtsubo '690 does not anticipate claim 1 and that the rejection of claim 1 based on Ohtsubo '690 should be withdrawn.

In addition, Ohtsubo '690 does not disclose packing ratios defined by grit size fractions as recited in claim 2. Therefore, applicants submit that Ohtsubo '690 does not anticipate claim 2 and that the rejection of claim 2 based on Ohtsubo '690 should be withdrawn.

In view of the above, applicants submit that Ohtsubo '690 does not disclose the subject matter of claims 1 and 2 and, accordingly, request withdrawal of this rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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